

REMARKS

Favorable reconsideration is respectfully requested in view of the foregoing amendments and the following remarks.

I. CLAIM STATUS & AMENDMENTS

An RCE, requesting entry of the response filed November 3, 2004, hereby accompanies this response.

Claims 1, 13 and 15-17 were examined and rejected in the final Office Action. Claims 2-12 were withdrawn as non-elected subject matter.

Claims 1-13 and 15 are now pending due to the entry of the November 3, 2004 response.

Claims 13 and 15 have been amended to include the units of concentration as disclosed in the specification, at page 6, lines 14-15. This amendment overcomes the concern raised in item 3 of the Advisory Action.

Therefore, no new matter has been added by this amendment.

II. ADVISORY ACTION -- REJECTIONS WITHDRAWN

As noted by the Examiner in item 2 on page 2 of the Advisory Action, the November 3, 2004 response overcomes the 112 second paragraph indefiniteness rejection, the 112 first paragraph written description rejection, and the 102(a) and 103(a) prior art rejections.

III. REJECTION UNDER 35 U.S.C. § 112, FIRST PARAGRAPH, ENABLEMENT

In item 3 on page 2 of the Advisory, it is indicated that the 112 first paragraph scope of enablement rejection of claims 13 and 15 would be maintained even upon entry of the November 3, 2004 response.

This position is respectfully traversed as applied to the amended claims for the reasons set forth in section V on pages 6-7 of the November 3, 2004 response. Specifically, claims 13 and 15 were amended to delete the percent homology language and to recite the specific stringent hybridization conditions disclosed in the specification as suggested by the Examiner during the

interview on October 19, 2004. During the interview, it was clarified that claims 13 and 15 were rejected under 35 U.S.C. § 112, first paragraph, for a lack of enablement regarding the recitation of % homology language coupled with functional language. Thus, the prior amendment overcomes this rejection by removing the rejected variant language regarding modifications and low percent homology.

Furthermore, as discussed in the previous response, it would only require routine experimentation for the skilled artisan to isolate DNA that hybridizes under stringent conditions to SEQ ID NO: 1 and use such DNA to produce a protein having the claimed cyclic depsipeptide synthetase activity.

Therefore, the scope of enablement rejection under 35 U.S.C. § 112, first paragraph, is untenable and should not be applied to amended claims 13 and 15.

CONCLUSION

In view of the foregoing amendments and remarks, it is respectfully submitted that the present application is in condition for allowance and early notice to that effect is hereby requested.

If it is determined that the application is not in condition for allowance, the Examiner is invited to telephone the undersigned attorney at the number below if he has any suggestions to expedite allowance.

Respectfully submitted,

Naoki MIDOH et al.

By: Warren M. Cheek, Jr.
Warren M. Cheek, Jr.
Registration No. 33,367
Attorney for Applicant

WMC/JFW/ksh
Washington, D.C. 20006-1021
Telephone (202) 721-8200
Facsimile (202) 721-8250
December 23, 2004